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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,940	08/10/2001	Arun Prasad	JPP-1260A NP	6062

7590 10/28/2002

JENERIC/PENTRON, INC.
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EXAMINER

WESSMAN, ANDREW E

ART UNIT PAPER NUMBER

1742

8

DATE MAILED: 10/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

VB

Office Action Summary	Application No. 09/927,940	Applicant(s) PRASAD, ARUN	
	Examiner Andrew E Wessman	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 remain for examination. Claims 1, 8, and 15 have been amended.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the claims, the percentages of various elements in the alloy are recited, but it is unclear as to what basis the percentages are taken from. It is necessary that the claims are rewritten to recite percent by weight, as is written in the specification.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prasad et al. (U.S. Patent No. 4,530,664).

Prasad et al. is applied to the claims for the reasons set forth in paper No. 6, paragraph 6.

With regards to the amended feature of claim 1, wherein Manganese is present in amounts greater than 2%, as mentioned in the previous office action, the ranges of

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the prior art need not completely encompass the ranges of the claimed invention.

Where the claimed ranges overlap or lie within the ranges disclosed by the prior art, a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90

(CCPA 1976). Furthermore, a prima facie case of obviousness exists where the

claimed ranges and the prior art ranges do not overlap but are close enough that one

skilled in the art would have expected them to have the same properties. Titanium

Metals Corp. of America v. Banner 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

MPEP 2144.05. With regards to the manganese content, it is the examiner's contention

that the high end of the prior art range (2%) is substantially the same as the claimed

invention's range low end of "greater than 2%" (which can be 2.001%). Applicant must

show some unexpected advantage for the alloy having a minor amount of manganese

in excess of 2% compared to exactly 2% to show the patentability of the claims.

Claim 8 has been amended to clarify the claim without changing the scope of the claim.

6. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prasad et al. in view of Chiaramonte.

Prasad et al. in view of Chiaramonte is applied to the claims for the reasons set forth in paper No. 6, paragraph 7.

Claim 15 has been amended to clarify the claim without changing the scope of the claim.

Response to Arguments

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7. Applicant's arguments filed August 19, 2002 have been fully considered but they are not persuasive. In the remarks, applicant argues that the prior art does not teach the amount of manganese present in the claimed invention, nor does the prior art provide sufficient motivation to add gold to the invention as taught by the secondary reference of Chiaramonte.

With regards to applicant's arguments pertaining to the manganese content, these are addressed in above paragraph 5.

With regards to applicant's arguments concerning the addition of gold to the alloy, Chiaramonte teaches (col. 2, line 57 to col. 3, line 9) the addition of gold not only to change the color of the alloy but also to lower the melting point and improve the mechanical properties of the alloy. Applicant's argument that the teachings of Chiaramonte with respect to changing the color of the alloy do not address the other reasons one of ordinary skill in the art would have to modify the alloy by the addition of gold, such as to lower the melting point and improve mechanical properties. Furthermore, Chiaramonte teaches amounts of from 0 to 40% gold added to the alloy, and a preferred range of 3 to 15%, which includes the amounts less than 5% that would have no effect on the color of the alloy. It is also not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). In this case the teaching to add the gold to the alloy to affect the color of the alloy is sufficient motivation to make the combination, despite it not being the motivation of the applicant.

Conclusion

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew E Wessman whose telephone number is (703)305-3163. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703)308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

AEW
October 24, 2002

ROY KING 
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700